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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,775	12/08/2000	Hans A. Mische		2947
28534	7590	03/18/2009	EXAMINER	
MIRICK, O'CONNELL, DEMALLIE & LOUGEE, LLP			PATEL, NIHIR B	
1700 WEST PARK DRIVE			ART UNIT	PAPER NUMBER
WESTBOROUGH, MA 01581			3772	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/733,775	<b>Applicant(s)</b> MISCHE, HANS A.
	<b>Examiner</b> NIHIR PATEL	<b>Art Unit</b> 3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

1) Responsive to communication(s) filed on 12/19/2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1, 2, 9, 10, 16, 17 and 25-27 is/are pending in the application.

4a) Of the above claim(s) 3-8, 11, 14, 15 and 18-24 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1, 2, 9, 10, 16, 17 and 25-27 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/89/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1, 2, 9, 10, 16, 17 and 25-27 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims **1, 2, 9 and 16** are rejected under 35 U.S.C. 102(b) as being anticipated by Scholten et al. (US 4,969,888).

4. **As to claim 1**, Scholten teaches an apparatus that comprises a delivery catheter **77** (**see figs. 22 and 23; col. 7 lines 1-10**); an expandable device for occupying space within bones (**see col. 7 lines 10-20**), releasably carried by the delivery catheter; and a means of expanding the device configured for removal from the bone upon expansion of the expandable device (**see col. 7 lines 25-40**); whereby the expanded device mechanically is configured to fixate the fracture after the delivery catheter and the means of expanding the device are moved from the bone (**see col. 7 lines 25-50**).

5. **As to claim 2**, Scholten teaches an apparatus wherein the means of expanding the device is an inflatable catheter configured for removal from the bone after expanding the expandable device (**see col. 7 lines 25-50**).

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6. **As to claim 9**, Scholten teaches an apparatus wherein the expandable device joins separated bone fragments (**see col. 7 lines 25-50**).

7. **As to claim 16**, Scholten teaches an apparatus that comprises an expandable tubular device 77 (**see figs. 22 and 23; col. 7 lines 1-10**), a delivery device comprising a balloon 76 (**see figs. 22 and 23; col. 7 lines 1-50**); the expandable tubular device removably attached to the balloon, whereby the balloon expands the tubular device at the treatment site, whereby the balloon is configured to be removed after leaving the expanded tubular device in place to span bone segments (**see col. 7 lines 25-50**).

#### *Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims **10 and 25-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Scholten et al. (US 4,969,888).

11. **As to claim 10 and 25-27,** Scholten substantially discloses a method steps of providing an expandable device for occupying space within a bone segment creating an access hole in bone (**see col. 6 lines 40-50**); dispensing the expandable device upon a delivery device 77 (**see figs. 22 and 23; col. 7 lines 1-10**), the delivery device comprising a balloon 77 (**see figs. 22 and 23**); inserting the expandable device through the access hole within the bone segment; advancing the expandable device to a desired location within the bone segment; inflating the balloon in order to cause expansion of the expandable device (**see col. 7 lines 15-30**); removing the balloon from the bone and hardening a substance within the bone segment after the removing the balloon sep (**see col. 7 lines 31-67**).

The method steps would have been obvious because they would have resulted from the use of the device of Scholten.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scholten et al. (US 4,969,888) in view of Beyar (US 6,127,597).

13. **As to claim 17,** Scholten substantially discloses the claimed invention; see rejection of claim 16 above, but does not disclose an expandable device that comprises a tubular mesh. Beyar discloses an apparatus that does provide an expandable device that comprises a tubular mesh (**see figs. 7A-7D**). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Scholten's invention by providing an expandable device that comprises a tubular mesh as taught by Beyar in order to make it more flexible so that expands to its fullest capability.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIHIR PATEL whose telephone number is (571)272-4803. The examiner can normally be reached on 7:30 to 4:30 every other Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nihir Patel/  
Examiner, Art Unit 3772

/Patricia Bianco/  
Supervisory Patent Examiner, Art Unit 3772